

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: Nicholas RUSSELL, et al.

Serial No.: 10/522,809

Group Art Unit: To Be Assigned

Filed: January 31, 2005

Examiner: To Be Assigned

For : ANIMATED MESSAGING

**REQUEST FOR RECONSIDERATION AND ADDITIONAL INFORMATION  
PROVIDED REGARDING PETITION UNDER 37 CFR 1.47(a)**

**MAIL STOP PETITIONS**

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

Sir:

In response to the Decision on Petition dated January 20, 2006, applicants respectfully request reconsideration and provides additional information directed to specific points set forth in the Decision.

The original petition included the signed declaration of Nicholas Russell as set forth below for easy reference and without signature.

I, Nicholas Russell, declare as follows:

1. I am a co-inventor of the inventions described and claimed in this application. Based on my understanding of the patent law of the United States of America, I believe that Nicholas Russell, Anton Felich and James Jenkins are co-inventors of inventions described in the specification and the claims as originally filed in the United States Patent and Trademark Office.

2. I am presently employed by E-Clips Intelligent Agent Technologies Pty Ltd. (assignee of this application). My address at E-Clips Intelligent Agent Technologies Pty Ltd is 11 Merran Court, Wheeler Hill, VIC 3150, Australia.

3. At the time we made the inventions described in this application, I, Nicholas Russell, and Anton Felich were employed by E-Clips Intelligent Agent Technologies Pty Ltd, which was subsequently purchased by InChain Pty Ltd.

4. I have read the Notification Of Missing Requirements under 35 U.S.C. 371 in The United States Designated/Elected Office (DO/EO/US).

5. I understand that the U.S. Patent and Trademark Office requires the signature of each inventor on the Declaration/Power Of Attorney and Assignment forms.

6. My co-inventor Anton Felich has been presented with a declaration and an Assignment related to this patent application and refuses to sign those documents.

7. Anton Felich is no longer employed by InChain Pty Ltd.

8. Declaration and Assignment forms for this application were forward to Anton Felich for his signature in February 2005. However, after at least three telephone calls and a plurality of email reminders some of which are dated March 9, 2005, April 6, 2005 and May 24, 2005 Anton Felich advised that he refuses to sign the Declaration and Assignment on the advice of counsel.

9. I Nicholas Russell, am the only co-inventor still associated with InChain Pty Ltd and have signed the Declaration and Assignment on behalf of Anton Felich.

10. I declare, under penalty of the perjury laws of the United States, that all statements made herein of my own knowledge are true and that all statements made based on information and belief are believed to be true, and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine

or imprisonment, or both, under §1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the application, any patent issuing thereon, or any patent to which this verified statement is directed.

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Nicholas Russell

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Date

The Decision of January 20, 2006 indicated that further information was required regarding petition requirements:

Item 3 - Clear Statement of last known address of the missing inventor.

Item 2 – More detailed statement of facts indicating that the missing inventor was presented with the application.

Further information provided as to Item 3

The missing inventors last known address is:

6 Grange Road  
Kalorama  
VIC 3766  
Australia

as set forth in the email exchanges attached hereto as Appendix A.

Further information provided as to Item 2

Appendix A contains various emails exchanged between co-inventor Nick Russell (who has signed) and co-inventor Anton Felich who has refused to sign the US patent application. The emails make it clear that the application was presented to Anton Felich and that, based on professional advice received, he refused to sign the application.

The following is the chronology of emails that explain part of the effort to obtain the signature of the “missing” inventor.

March 9, 2005 email from Nick Russell (co-inventor) to Anton Felich (inventor who refuses to sign). indicating that Anton Felich needs to sign “paperwork on the patent”. This refers to formal papers for filing the US application.

March 15, 2005 email from Anton Felich (inventor who refuses to sign) to Nick Russell (co-inventor)

April 6, 2005 email from Nick Russell to Anton Felich following up on the signing of formal papers for US patent application.

April 14, 2005 email from Anton Felich to Nick Russell indicating that he sought advice of a lawyer with respect to patent paperwork (formal papers for US application).

May 24, 2005 email from Nick Russell to Anton Felich asking if Anton Felich had a chance to follow up on paperwork (formal papers for US patent application).

May 24, 2005 email from Anton Felich to Nick Russell indicating that he had been advised to NOT SIGN.

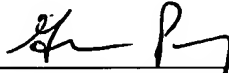
Together, these emails indicate that Mr. Felich was presented with the formal papers for filing the US counterpart application and that Mr. Felich, based on professional advice, refused to sign those papers. There is no issue as to whether or not papers were presented for signature. It is clear that there was a conscious decision on the part of Mr. Felich to NOT SIGN the US application.

If any fees are due in connection with the filing of this Renewed petition, such as fees under 37 C.F.R. §§1.16 or 1.17, please charge the fees to Deposit Account 02-4300; Order No. 034164.002.

Respectfully submitted,  
SMITH, GAMBRELL & RUSSELL, LLP

Date: March 28, 2006

By:



Glenn J. Perry, Reg. 28,458  
1850 M Street, N.W., Suite 800  
Washington, DC 20036  
Telephone: 202/263-4300  
Facsimile: 202/263-4311

## Appendix A

From: Anton Felich [anton.felich@clearweb.com.au]

Sent: Tuesday, May 24, 2005 4:13 PM

To: Nick Russell

Subject: RE: Patent stuff

Hey ya Nick,

Yeah spoke to him yesterday and he advised me not to sign it, something about liability or responsibility if it goes to market or something, I didn't really understand what he meant.

Is there anything else I can do to help ya out?

Cheers,

Anton

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From: Nick Russell [mailto:nick@inchain.com.au]

Sent: Tuesday, 24 May 2005 12:01 PM

To: anton.felich@clearweb.com.au

Subject: FW: Patent stuff

Hi Anton,

Have you had a chance to follow up with the lawyer re that paperwork? Our patent lawyer is chasing me on it.

Nick

---

From: Anton Felich [mailto:anton.felich@clearweb.com.au]

Sent: Thu 14/04/2005 12:03 PM

To: Nick Russell

Subject: RE: Patent stuff

Hey Nick,

Sorry about the delay, didn't understand some of the stuff in the document so I gave it to one of the lawyers to interpret for me, will follow it up with him today for ya.

Cheers,

Anton

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From: Nick Russell [mailto:nick@inchain.com.au]  
Sent: Wednesday, 6 April 2005 10:57 PM  
To: anton.felich@clearweb.com.au  
Subject: FW: Patent stuff

Hi Anton,

Have you had a chance to sign the patent paperwork as yet?

Nick

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From: Nick Russell  
Sent: Wed 9/03/2005 2:58 PM  
To: anton.felich@clearweb.com.au  
Subject: Paperwork

Hi Anton,

How goes it, what are you up to on your side of the world? I've got some of the paperwork on the patent that I need to get you to sign. Are you still at the same address or have you moved? Can you send me over the details and I will forward the paperwork. Let me know and fill me in on how it's going

Cya

Nick

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Inchain Pty Ltd  
1270 Ferntree Gully Road,  
Scoresby, VIC 3179  
Australia

Tel: +61 3 9730 3991  
Fax: +61 3 9730 3992  
Email: [nick@inchain.com.au](mailto:nick@inchain.com.au)

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From: Anton Felich [anton.felich@clearweb.com.au]  
Sent: Tuesday, March 15, 2005 5:45 PM  
To: Nick Russell  
Subject: RE: Paperwork  
Hey Nick,

All good here, I'm all over the place at the moment so might get you to send it to mum and dads and I'll take care of it next time I see them.

6 Grange Road  
Kalorama  
VIC 3766

Cheers,

Anton

---

From: Nick Russell [mailto:nick@inchain.com.au]  
Sent: Wednesday, 9 March 2005 2:58 PM  
To: anton.felich@clearweb.com.au  
Subject: Paperwork

Hi Anton,

How goes it, what are you up to on your side of the world? I've got some of the paperwork on the patent that I need to get you to sign. Are you still at the same address or have you moved? Can you send me over the details and I will forward the paperwork. Let me know and fill me in on how it's going

Cya

Nick

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1270 Ferntree Gully Road,  
Scoresby, VIC 3179  
Australia

Tel: +61 3 9730 3991  
Fax: +61 3 9730 3992  
Email: [nick@inchain.com.au](mailto:nick@inchain.com.au)



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